



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/583,476	06/19/2006	Christophe Martin	1032326-000394	3680

21839 7590 08/27/2010
BUCHANAN, INGERSOLL & ROONEY PC
POST OFFICE BOX 1404
ALEXANDRIA, VA 22313-1404

EXAMINER

KUDDUS, DANIEL A

ART UNIT	PAPER NUMBER
----------	--------------

2164

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

08/27/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com
offserv@bipc.com

Office Action Summary	Application No. 10/583,476	Applicant(s) MARTIN ET AL.	
	Examiner DANIEL KUDDUS	Art Unit 2164	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This Office action has been issued in response to amendment filed Jun 21, 2010. In response to last office action, independent claims 11, 18 19 have been amended. Claims 11-20 are pending in this application. Applicant's arguments are carefully and respectfully considered and some are persuasive, while others are not. Accordingly rejections have been removed where arguments were persuasive, but rejections have been maintained where arguments were not persuasive. Also, a new rejections based on the newly added amendment have been set forth. Accordingly, claims 11-20 are rejected and this action has been made **FINAL**, as necessitated by amendment.

Response to Arguments

2. With respect to applicant's arguments on pages 8-12, "*Sarskog cannot support a rejection of claim 11 under 35 U.S.C. § 102(b) because the reference fails to disclose.... fails to disclose or suggest a method of backing up personal data as recited in claim 11... silent with respect to first dividing the information in the SIM card into subsets and then individually sending each subset at predetermined times... Van Reenen is entirely silent with respect to first dividing the information saved in the mobile phone into plurality of subsets, sending a first subset from the plurality of subsets, waiting a predetermined amount of time, and then sending another subset from the plurality of subsets...not analogous...not meet requirement...claims 18 and 19 ..recites similar feature...similar to those in connection with claim 11..19 and 20 is also patentably distinct from Van Reenen*". In response to applicant's arguments, Examiner indicates

Art Unit: 2164

claims 11-20 are rejected under new ground of rejection. As such, the arguments are moot.

Sarskog teaches claim recites limitations a method of backing up personal data of a wireless communication network subscriber (see figure 1, telephone 1, and 3, page 1, line 6-15, identify of the subscriber...mobile telephone with the mobile telephone system of a network operator), prepared a first subset of data from, and transmitted the first subset of data to a network server for backing up (see page 1, line 31 to page 3, line 18, information that has been stored in a so-called SIM card for mobile telephony (i.e. backup)...content of telephone book (i.e. telephone book has subset of data) is caused to be transferred to a computer, figure 1), the backup is delayed by a predetermined period of time, so as to free the mobile communication device for a user of the mobile communication device and the backup of at least one other subset of data, subsequent to the first subset of data is resumed at the end of said predetermined period of time (see page 2, line 1-6, page 2, line 25-30, content of the telephone book to the affiliated memory of a computer at predetermined time intervals for safe storage of said information, via a mobile telephone system. The computer is caused to transfer said information content to a new SIM card replacement in response, via a mobile telephone system).

Sarskog does not explicitly teach the amended claim recites limitations divided a batch of data to be backed up into a plurality of subsets, the plurality of subsets, from the plurality of subsets. Although, Sarskog teaches (see page 1, line 11-12, e.g. telephone numbers stored by the user). However, Van Reenen teaches clearly teaches such limitations (see page 2, line 13 to page 4, line 6, data that is backed up may be the names and telephone numbers stored in the telephone device, calendar data, addresses, files, notes, tasks, graphics and the like).

Therefore, combination of references teaches claim recites limitations.

Art Unit: 2164

3. With respect to applicant's arguments on pages 12-16, "*Dormehl and Jouenne, taken alone or in proper combination, fail to disclose each element recited in claim 11... does not in any way pertain to the manner in which information is transmitted from the phone to the server...entirely silent with respect to first dividing information in the mobile phone into a plurality of subsets, sending a first subset from the plurality of subsets, waiting a predetermined amount of time, and sending another subset from the plurality of subsets.... no way can be construed as preparing "a first subset of data from among a batch of data to be backed up and transmitting the first subset of data to a network server for backing up... nowhere in reference, let alone the cited portion, does Dormehl specifically teach backing up a subset of data from a plurality of subsets, waiting a predetermined period of time, and resuming backup of another subset from a plurality of subsets subsequent to the first subset..unsupported... Dormehl fails to disclose or suggest a method as recited in claim 11... Dormehl further fails to disclose or suggest asynchronous backup... like Dormehl, Jouenne is entirely silent with respect to first dividing information to be backed up into a plurality of subsets, sending a first subset from the plurality of subsets, waiting a predetermined amount of time, and sending another subset from the plurality of subsets, as recited in claim 11... neither Dormehl nor Jouenne, taken individually or in combination, disclose or suggest the claimed features and, therefore, cannot support a prima facie case for rejecting claim 11 under 35 U.S.C. § 103(a).... independent claims 18 and 19...recite at least some of the same distinguishing features noted above with respect to claim 11... arguments similar to those in connection with claim 11 are also applicable to claims 18 and 19... claims 12-17 and 20 are also patentably distinct from the cited references". The Examiner respectfully disagrees with applicant's arguments. Dormehl in*

Art Unit: 2164

fact teaches amended claim recites limitations. Dormehi teaches the limitation of a method of backing up personal data of a wireless communication network subscriber, the personal data being memorized within a mobile communication device and backed up within network server (see abstract, page 2, line 1-14), wherein said method includes, in which, once the mobile communication device has divided a batch of data to be backed up into a plurality of subsets, prepared a first subset of data from the plurality of subsets and transmitted the first subset of data to a network server for backing up (see page 1, line 6-10, page 3, line 3 to page 4, line 18, server being programmed to receive uploaded data from the memory of a mobile telephone; to store same in the associated database record (i.e. subset of data) and in the event that the 'relevant data base record' (i.e. subset of data) already has existing data stored therein, figure 1, page 2, line 1-14, page 3, line 19-23, already stored....the operation requested by the relevant mobile telephone user, wherein replace said existing data with the uploaded data or to compare the uploaded data with the existing data and to update the existing data referred here as divided into a plurality of subsets), the backup is delayed by a predetermined period of time, so as to free the mobile communication device for a user of the mobile communication device and the backup of at least one other subset of data from the plurality of subsets subsequent to the first subset of data is resumed at the end of said predetermined period of time (see page 3, line 18-28, data stored in the relevant data base record under predetermined conditions (i.e. predetermined amount of time) by way of the internet; for release of the data stored in a data base record to be dependent upon the supply of security information; note that, since data stored in the relevant data base record under predetermined conditions by way of the internet and data is released 'dependent upon supply of security information', therefore mobile device can be free

Art Unit: 2164

for predetermined period of time, which also teach delaying backup, page 5, line 9 to page 8, line 24, the database record may be subdivided into sub-records (i.e. plurality of subsets) if required so that data of a different nature can be separated out, page 2, line 1-4, backup procedure can..generally only be carried out (i.e. resume) when the mobile telephone and personal computer are physically present....when the user has access to the personal computer). As such, Dormehi teaches claim recites limitations except for the limitation of an asynchronous backup. Jouenne teaches such limitation (see column 1, line 48-50, e.g. asynchronous type backup). Note that, Jouenne also teaches the limitation of the backup is delayed by a predetermined period of time, so as to free the mobile device for a user of the mobile communication device; data is resumed at the end of said predetermined period of time (see column 3, line 64-67, transmission takes place either when no other call is expected between the stations, or else at the end of a predetermined time lapse, table 1).

Therefore, taken alone or in combination of reference teaches claim recites limitations. Since, references teaches claim recites limitations, as such a proper prima facie case of obviousness has been established. Dependent claims rely on independent claims, such as dependent claims 12-17 and 20 depend on claims 11 and 19 and the rejections have been addressed in the detailed office action.

It is a well settled rule that a reference must be considered not only for what it expressly teaches but also for what it fairly suggests. See *In re Burckel*, 592 F.2d 1175, 201 USPQ 67 (CCPA 1979) and *In re Lamberti*, 545 F.2d 747, 192 USPQ 278 (CCPA 1976) as well as *In re Bode*, 550 F.2d 656, 193 USPQ 12 (CCPA 1977) which indicates such fair suggestions to unpreferred embodiments must be considered even if they were not illustrated. Additionally, it

Art Unit: 2164

is an equally well settled rule that what a reference can be said to fairly suggest relates to the concepts fairly contained therein, and is not limited by the specific structure chosen to illustrate such concepts. See *In re Bascom*, 230 F.2d 612, 109 USPQ 98 (CCPA 1956).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 11, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sarskog, Johan (WO 01/62029 A1), hereinafter Sarskog and further in view of Van Reenen et al. (WO 03/037015 A1), hereinafter Van.

As for claim 11, Sarskog teaches **a method of backing up personal data of a wireless communication network subscriber, the personal data being memorized within a mobile communication device and backed up in a network server** (see abstract, figure 1), **wherein said method includes an asynchronous backup mode in which, once the mobile**

Art Unit: 2164

communication device has, prepared a first subset of data from, and transmitted the first subset of data to a network server for backing up (see page 1, line 31 to page 3, line 18, information that has been stored in a so-called SIM card for mobile telephonycontent of telephone book is caused to be transferred to a computer, figure 1), **the backup is delayed by a predetermined period of time, so as to free the mobile communication device for a user of the mobile communication device and the backup of at least one other subset of data, subsequent to the first subset of data is resumed at the end of said predetermined period of time** (see page 2, line 1-6, page 2, line 25-30, content of the telephone book to the affiliated memory of a computer at predetermined time intervals for safe storage of said information, via a mobile telephone system. The computer is caused to transfer said information content to a new SIM card replacement in response, via a mobile telephone system).

Sarskog does not explicitly teach the amended claim recites limitations **divided a batch of data to be backed up into a plurality of subsets, the plurality of subsets, from the plurality of subsets**. Although, Sarskog teaches (see page 1, line 11-12, e.g. telephone numbers stored by the user). However, Van Reenen teaches clearly teaches such limitations (see page 2, line 13 to page 4, line 6, data that is backed up may be the names and telephone numbers stored in the telephone device, calendar data, addresses, files, notes, tasks, graphics and the like).

Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to have modified the teaching of Sarskog by applying the teaching of Van Reenen for controlling connection to the back up facility and the transfer of data to and from the back up storage, thereby data may be backed up automatically (see Van Reenen, page 2, line 11-16).

Claim 18 have the same subject matter as claim 1 except for the limitation of server for backing up and Van teaches such limitation (see figure 1). Therefore, claim 18 is rejected for the same reason as applied to claim 1 hereinabove.

Claim 19 have the same subject matter as claim 1 except it is directed to portable wireless communication device and Van teaches such limitation (see figure 1). Therefore, claim 19 is rejected for the same reason as applied to claim 1 hereinabove.

5. Claims 11-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dormehi et al. (WO 03/007639 A1), hereinafter Dormehi and further in view of Jouenne et al. (US 6,286,085 B1), hereinafter Jouenne.

Dormehi teaches the limitation of **a method of backing up personal data of a wireless communication network subscriber, the personal data being memorized within a mobile communication device and backed up within a network server** (see abstract, page 2, line 1-14), **wherein said method includes, in which, once the mobile communication device has divided a batch of data to be backed up into a plurality of subsets, prepared a first subset of data from the plurality of subsets and transmitted the first subset of data to a network server for backing up** (see page 1, line 6-10, page 3, line 3 to page 4, line 18, server being programmed to receive uploaded data from the memory of a mobile telephone; to store same in the associated database record and in the event that the relevant data base record already has existing data stored therein, figure 1, page 2, line 1-14, page 3, line 19-23, already stored....the operation requested by the relevant mobile telephone user), **the backup is delayed by a predetermined period of time, so as to free the mobile device for a user of the mobile communication device and the backup of at least one other subset of data from the**

Art Unit: 2164

plurality of subsets subsequent to the first subset of data is resumed at the end of said predetermined period of time (see page 3, line 18-28, data stored in the relevant data base record under predetermined conditions by way of the internet; for release of the data stored in a data base record to be dependent upon the supply of security information; page 5, line 9 to page 8, line 24, the database record may be subdivided into sub-records if required so that data of a different nature can be separated out, page 2, line 1-4, backup procedure can..generally only be carried out when the mobile telephone and personal computer are physically present....when the user has access to the personal computer).

Dormehi does not explicitly teach the limitation of an asynchronous backup. Jouenne teaches such limitation (see column 1, line 48-50, e.g. asynchronous type backup).

Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to have modified the teaching of Dormehi by applying the teaching of Jouenne to backing up data and results in a system in which backup is optimized under all situations. Further, data backup would be secure and prevent any data loss between stations (see Jounne, column 1, line 55-62).

As for claim 12, Dormehi teaches **wherein, in order to resume the backup, the mobile device implements a countdown of the period and sends a resume signal to a chip card in the mobile device at the end of said predetermined period of time** (see page 5, line 9-19).

As for claim 13, Dormehi teaches **wherein, in order to resume the backup, the mobile device implements a countdown of the period and sends a resume signal to a chip card in the mobile device at the end of said predetermined period of time** (see page 5, line 9-19).

As for claim 14, Dormehi teaches **wherein the mobile implements the countdown and sends the resume signal upon receiving an instruction from the chip card** (see page 5, line 9-19).

As for claim 15, Dormehi teaches **wherein the chip card gives said instructions to the mobile device by sending it a Subscriber Identity Module toolkit (“STK”) command** (see page 3, line 18-32).

As for claim 16, Dormehi teaches **wherein the chip card gives said instructions to the mobile communication device by sending it a ‘GET STATUS’ commands** (see page 2, line 7-14).

As for claim 17, Dormehi teaches **a prior assessment step which determines whether the volume of data to be backed up or a corresponding waiting time required to make the mobile device available to the user is determined and compared to a predetermined threshold** (see page 2, line 16-22, page 3, line 10-16), **when the volume of data higher than the predetermined threshold, the backup is performed, when the volume of data is not higher than the predetermined threshold, the backup is carried out according to default mode** (see page 3, line 18 to page 4, line 2).

Dormehi does not explicitly teach according to the asynchronous backup mode. Jounne teaches such limitation (see column 1, line 48-50).

Claim 18 have the same subject matter as claim 1 except for the limitation of server for backing up and Dormehi teaches such limitation (see figure 1). Therefore, claim 18 is rejected for the same reason as applied to claim 1 hereinabove.

Claim 19 have the same subject matter as claim 1 except it is directed to portable wireless communication device and Dormehi teaches such limitation (see figure 1) and is rejected for the same reason as applied to claim 1 hereinabove.

As for claim 20, Dormehi teaches **wherein said device selectively operates, and a normal mode** (see page 6, line 30 to page 7, line 4).

Dormehi does not explicitly teach according to the asynchronous backup mode. Jounne teaches such limitation (see column 1, line 48-50).

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Daniel A Kuddus whose telephone number is (571) 270-1722. The

Art Unit: 2164

examiner can normally be reached on Monday to Thursday 8.00 a.m.-5.30 p.m. The examiner can also be reached on alternate Fridays from 8.00 a.m. to 4.30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Charles Rones can be reached on (571) 272-4085. The fax phone number for the organization where this application or processing is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from the either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Daniel Kuddus

Date: 08/24/10

/Charles Rones/

Supervisory Patent Examiner, Art Unit 2164

Application/Control Number: 10/583,476
Art Unit: 2164

Page 14